

**REMARKS**

This Amendment and Request for Reconsideration is submitted in response to an outstanding Office Action (Final Rejection) dated February 8, 2005, the shortened statutory period for response set to expire on May 8, 2005. Accordingly, no extension of time is believed due. In the event that the Commissioner determines that an extension of time is due, the undersigned hereby petitions for such extension and authorizes the Commissioner to charge any required fee to the Milbank Deposit account 13-3250.

I. Status of the Claims

Please amend claims 1 and 12-18 as indicated above. Claims 1-6 and 8-18 are now pending in the application. Claims 1, 12, 17 and 18 are independent claims.

Applicants acknowledge the Examiner's citation of statutory authority as a basis for claim rejections.

II. Objections

The Examiner has objected to prior amendments of claims 1, 17 and 18 as introducing new matter, in particular the limitations "wherein said tongue depressor does not have a protective layer" (claims 1, 17 and 18) and "wherein both ends of said tongue depressor may be safely received within said mouth of said patient during said examination without causing any discomfort or physical harm" (claims 1 and 17). The Examiner has required cancellation of these limitations. Applicants submit that the language "wherein said tongue depressor does not have a protective layer" is supported by the original disclosure at Specification page 4, lines 13-16. Applicants further submit that the language "wherein both ends of said tongue depressor may be safely received within said mouth of said patient during said examination without causing any discomfort or physical harm" is supported by the original disclosure at Specification page 6, lines

1-3. Applicants therefore request reconsideration of these objections. The request for reconsideration notwithstanding, Applicants have cancelled the language in question and ask that the Examiner withdraw the objection.

The Examiner has objected to an informality in claims 1, 17 and 18 because the word "Wherein" is capitalized. Applicants' amendment overcomes the objection and applicants ask that the Examiner withdraw the objection.

III. Rejections under 35 U.S.C. § 112

The Examiner has rejected claims 1-6, 8-11 and 13-16 under 35 U.S.C. § 112 as being indefinite, where "the standard size used with youthful patients" lacks antecedent basis. Applicants submit that "the standard size used with youthful patients" can be determined by one having ordinary skill in the art, and thus request reconsideration of this rejection. The request for reconsideration notwithstanding, Applicants amendment overcomes the rejection and applicants ask that the Examiner withdraw the rejection.

IV. Rejections under 35 U.S.C. § 102

The Examiner has rejected claims 12, 17 and 18 under 35 U.S.C. § 102 as being anticipated by Esker et al, or Daly et al.

As amended, claim 12 requires: an apparatus for motivating the cooperation of youthful patients in oral examinations, comprising a standard size tongue depressor for use with a self-illuminating tongue depressor handle attachment for restraining a tongue of a patient to allow clearer examination of a rear of a patient's mouth and throat, comprising a blade having two elongated, substantially flat surfaces for restraining said tongue of said patient, at least one of said two surfaces bearing an ornamental image along at least a portion thereof intended to be inserted into said patient's mouth, said ornamental image being made from non-toxic ink.

Support for the amendment of claim 12 is found in the original specification, which states at page 5, lines 6-10, “many of the prior art inventions cannot be used with a standard instrument used by doctors that holds a standard shaped tongue depressor and illuminates the patient’s mouth. This commonly used instrument (a self-illuminating tongue depressor handle attachment) accommodates only tongue depressors of standard shape.” Page 7, lines 20-23 of the original specification states” [t]ongue depressor 10 can be a standard size or any other size whose length and width is appropriate for use as a tongue depressor.”

Esler et al discloses a handle for a food product. There is no disclosure or suggestion in Esler of a “standard size tongue depressor for use with a self-illuminating tongue depressor handle attachment.” Similarly, in Daly et al, there is no disclosure or suggestion of a “standard size tongue depressor for use with a self-illuminating tongue depressor handle attachment.” Accordingly, applicants respectfully ask the Examiner to withdraw the rejection of claim 12 under 35 U.S.C. § 102 over Esler et al. or Daly et al.

Amended claims 17 and 18 include a similar limitation, which is not disclosed or suggested by either Esler et al or Daly et al. Accordingly, applicants ask the Examiner to withdraw the rejection of claims 17 and 18 under 35 U.S.C. § 102 over Esler et al. or Daly et al.

V. Rejections under 35 U.S.C. § 103

The Examiner has rejected claims 1-6, 9, 11 and 13-16 under 35 U.S.C. § 103 as being unpatentable over Esler et al. The Examiner states that Esler discloses all of the claimed limitations except a device having the specific size claimed. The Examiner states that it would have been obvious to provide the device of Esler in any of numerous sizes, since a mere change in the size of a component is generally recognized as being within the level of ordinary skill in the art.

As amended, claim 1 requires a tongue depressor for receipt within a mouth of a patient during an examination, comprising: a blade comprising first and second sides separated by a thickness of said blade, said blade further comprising first and second tongue contact portions located along said first and second sides, respectively; and an ornamental image appearing along at least a portion of at least said first tongue contact portion of said first side; wherein said tongue depressor is a standard size for use with a self-illuminating tongue depressor handle attachment, said tongue depressor is not coated with flavor, and any portion of said tongue depressor blade may be received within said mouth of said patient during said examination, even if said any portion of said tongue depressor has said ornamental image appearing therealong.

The Declaration of Dr. Mehrotra, submitted October 11, 2004, identifies standard sizes for tongue depressors. In particular, Adults (regular/Reg), Seniors (Standard/Std.), and children (Junior/Jr.). The attachments to Dr. Mehrotra's Declaration list the respective sizes of the regular as 6" x 3/4"; standard as 6" x 11/16"; and junior as 5 1/2" x 5/8". Although not listed in the declaration or on the attachments, the size of an infant depressor is 4 1/2" x 3/8". Other than the infant depressor, these standard size tongue depressors (*i.e.*, standard, regular and junior) fit in the self-illuminating tongue depressor handle attachment and are held firmly. In contrast, a smaller size blade, such as a popsicle stick or infant size depressor is not held firmly in the self-illuminating tongue depressor handle attachment. In fact, when a blade the size of an infant depressor or popsicle stick is placed in a self-illuminating tongue depressor handle attachment the blade can pivot or swing from side to side. This is entirely unsatisfactory and could lead to potential injury of a patient because the blade is not controlled.

Applicants submit that a standard size for use with a self-illuminating tongue

depressor handle attachment is not “any of numerous sizes” but is one of a particular and known set of sizes, (*i.e.*, regular, standard, or junior), and the Examiner has not identified any teaching or suggestion in Esker or elsewhere for this limitation.

The Examiner has rejected claims 1-6 and 8-16 under 35 U.S.C. § 103 as being unpatentable over Daly et al. As with Esker, the Examiner states that Daly discloses all of the limitations except the specific size claimed by applicant. For the same reasons provided above with respect to Esker, applications submit that Daly et al does not teach or suggest all of the limitations of independent claims 1, and 12.

The Examiner has rejected claims 1-6 and 8-16 under 35 U.S.C. § 103 as being unpatentable over Chen et al. in view of Esker et al. The Examiner acknowledges that Esker does not disclose the particular size, and relies on Chen to disclose a tongue depressor. The Examiner also admits that Chen does not disclose providing an ornamental image. In what appears to be the motivation to combine Chen and Esker, the Examiner states that the combination would “make the device attractive and entertaining and to make the device more valuable to the user.” Applicants submit that this is a pure hindsight motivation to combine, taken directly from the disclosure of applicants’ invention. Except from the teachings of applicant’s own disclosure, which is not admitted prior art, the Examiner has not identified any particular motivation to combine these two particular references and Applicants’ submit that is improper.

At least for these reasons, Applicants submit that the rejections based on Esker et al., Daly et al. and Chen et al. either individually or in combination are not supported, and ask that the rejections be withdrawn.

VI. Request for Reconsideration

Applicants respectfully submit that the claims of this application are in condition for allowance. Accordingly, reconsideration of the rejection and allowance is requested. If a conference would assist in placing this application in better condition for allowance, the undersigned would appreciate a telephone call at the number indicated.

Respectfully submitted,  
Milbank, Tweed, Hadley & McCloy LLP



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